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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,485	04/06/2001	Thomas Brumm	112740-209	5739
29177	7590	09/16/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC			RYMAN, DANIEL J	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			2665	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/827,485

Applicant(s)

BRUMM ET AL.

Examiner

Daniel J. Ryman

Art Unit

2665

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____.

HBY D. VU

**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**

Continuation of 3. NOTE: The amendments add further limitations to the claims which were not previously considered. Further search and/or consideration is required in order to make a proper patentability determination. Therefore, the amendments will not be entered.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant asserts that the 35 U.S.C. 112 rejection is improper because "other variations are discussed where data packets used to transmit the second signaling information are transmitted in a part of the signaling packets which does not contain any first signaling information." Applicant then asserts that support for this limitation can be found on page 15, lines 1-15. After reviewing this passage, Examiner maintains that the claim limitation is not supported by the specification. The passage cited by Applicant only discloses "signaling information." It is never disclosed that this signaling information is packetized and then inserted into an additional packet. Examiner submits that inserting signaling information into a packet is not equivalent to packetizing the signaling information to create a packet and then inserting this packet into an additional packet, where the latter is required by claim 29. Examiner requests that Applicant either amend claim 29 to read "wherein the second signaling information is transmitted in a part of the signaling packets which does not contain any first signaling information" or point out in the specification a passage that discloses that the second signaling information is packetized before being inserted into the signaling packets.

Applicant further asserts that the combination is improper. Examiner, respectfully, disagrees. Applicant begins by asserting that Examiner cites to almost 14 pages of Applicant's specification, including portions of Applicant's disclosure, and then concludes that Examiner's rejection is improper because it uses Applicant's disclosure against Applicant. However, Examiner can only find citations to pages 1-4 of Applicant's disclosure (i.e. Applicant's admitted prior art) in the section of the Office Action related to prior art rejections. Although there is a citation to page 14 of the specification in the rejection of claim 29 under 35 U.S.C. 112, this citation does not relate to the prior art rejections. Therefore, Examiner maintains that Examiner has only used Applicant's admitted prior art against Applicant.

Applicant proceeds to assert that there is insufficient motivation to combine. Examiner, respectfully, disagrees. Su teaches a mechanism that allows a single device to communicate signaling in both a circuit-switched and a packet-switched network. However, Su does not teach that this device is a terminal device since Su's terminal device is solely packet-based. Applicant admits as prior art that there are multiple services for a terminal that are only available on circuit-switched networks (pg. 4, lines 3-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Su's method on a terminal device in order to allow the terminal device to access the services only available on circuit-switched networks.